



Docket No.: 826.1431

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re the Application of:

Hiroshi HARUKI et al.

Serial No. 08/971,903

Group Art Unit: 3622

Confirmation No. 4920

Filed: November 17, 1997

Examiner: James W. Myhre

For: COMPUTER-RELATED PRODUCT USER MANAGEMENT AND SERVICE SYSTEM

REPLY BRIEF

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted in response to the Examiner's Answer mailed August 1, 2005.

Teachings of Todd et al. Addressed by Examiner's Answer

The first issue raised by the Examiner in the Examiner's Amendment is what was disclosed by U.S. Patent 5,867,714 to Todd et al. For the first time in eleven Office Actions in this application, in item (10)(a) on pages 8 and 9 of the Office Action, the Examiner cited the table in columns 6-11 of Todd et al. as supporting the rejection. There was no reference to this table in the final rejection which is repeated on pages 3-7 of the Examiner's Amendment. It is submitted that if the Applicant is restricted by 37 CFR 41.41 to not submit new evidence in a Reply Brief, the Examiner should have the same restriction regarding changing the rejection in an Examiner's Answer. However, despite the Examiner's excessively late change in what is relied on from Todd et al., Applicants wish to proceed with the appeal, so that the issues raised in the Appeal Brief can be resolved by the Board of Patent Appeal and Interferences independently of the Examiner's reading into Todd et al. what is taught and claimed by the application.

The issues raised in the Appeal Brief regarding the lack of disclosure in Todd et al. relate to what information is transmitted "to a vendor other than the vendor of the software product being used by the user" (see the bottom of page 3 in the August 16, 2004 Office Action and page 4, lines 8-9 of the Examiner's Answer). The "disclosure in Todd et al." is what would be disclosed to one of ordinary skill in the art, not what the Examiner would imply is disclosed by Todd et al. after the Examiner has read the application which is the subject of this appeal. As stated repeatedly, most recently in the Appeal Brief, Applicants' position is that a mere list of software from multiple vendors in a database is insufficient to suggest to one of ordinary skill in the art that "user registration information ... is transmitted from the user to a different vendor other than the software product's vendor, that sells products that may be of interest to users of the particular software product" (e.g., claim 10, last 3 lines).

Page 9, lines 5-22 of the Examiner's Answer refers to the description in Todd et al. of "two examples of how the remote data source uses this data" (page 9, lines 5-6) extracted from a user's computer. Unlike the table in columns 6-11, these examples were previously cited by the Examiner and they were addressed repeatedly during prosecution of the application. As noted in the Examiner's Answer and in the Appeal Brief, the first example relates to the AT&T Tourguide Tutorial which, as discussed previously, is software created by the assignee of Todd et al. at the time that Todd et al. was filed. It is submitted that the conclusion at page 9, lines 13-15 of the Examiner's Answer does not follow from what is taught by Todd et al. The disclosure that information about a software product is sent to the vendor of that software product, i.e., AT&T in the case of AT&T Tourguide Tutorial, does not meet the limitations recited in the independent claims.

Furthermore, the discussion of "hardware" on page 9 at lines 14 and 15 and "the manufacturer of the user's computer" (page 9, last line), is not particularly relevant to the present invention. The only place that "hardware" is used in the claims is on lines 2 and 4 of claim 1. The other independent claims do not use the word "hardware" but simply refer to "a product used by a user" (e.g., claim 10, lines 4-5), a "computer-related product" (e.g., claim 10, line 7) or "a particular product" (e.g., claim 10, line 8). Given that Todd et al. describes a preferred embodiment using a manufacturer-independent, *de facto* standard, i.e., the so-called "IBM PC compatible" computer, differences between the vendor of the hardware and either the software discussed in Todd et al. or the operating system running the software is not particularly relevant. All of the independent claims require transmitting information "to a different vendor other than the **software** product's vendor, that sells products that may be of interest to users of the

particular **software** product" (e.g., claim 10, last two lines, emphasis added), or something similar. As repeatedly stated during prosecution of the application, providing such information to a different vendor of software is not done conventionally and is not hinted at in Todd et al.

The last seven lines on page 9 of the Examiner's Answer discusses "warranty information [that] pertains to the user's complete computer system" (Examiner's Answer, page 9, lines 18-19) which the Examiner asserts (without citation to anything in Todd et al.) is maintained at "the remote data source ... [in] a registration database" (Examiner's Answer, page 9, line 16-17). It is assumed that the Examiner is referring to the paragraph at column 12, lines 58-65 of Todd et al. which was discussed previously during prosecution of the application. This paragraph states that registration database 132 at remote data source 130 "may include warranty information that manages warranty obligations" (column 12, lines 64-65) for "those computer systems that are licensed or otherwise qualified to receive analysis and software revision" (column 12, lines 60-62). These words do not say what products are covered by the warranty information. The statement at column 12, lines 4-5 that "the current configuration data transmitted from the computer system 110 to the remote data source 130" does not require that all of the products in the configuration data have corresponding warranty information. Therefore, the Examiner has failed to cite anything in Todd et al. supporting the Examiner's position that the warranty information relates to a wide range of products from different vendors.

Key Issue Not Addressed by Examiner's Answer

Most importantly, the Examiner has failed to cite anything in Todd et al. suggesting that the remote or central data source transmits any information to anything other than the user's computer. Subitems (c) and (d) of item (10) on pages 11 and 12 of the Examiner's Answer relate to whether Todd et al. discloses "that the user registration information and user status information is transmitted to a vendor of the software product and to another vendor that sells products that may be of interest to users of the particular software product" (Examiner's Answer, page 11, lines 2-4). As discussed in the Appeal Brief and during prosecution of the application, Todd et al. only discloses communication between a user computer system 110 and remote data source 130, as illustrated in Fig. 1 and between central data source 330 and remote (user systems) 310A-310C, as illustrated in Fig. 3. On the other hand, claim 10, for example, recites "[a] management apparatus which manages user information about a computer-related product used by a user terminal connected through a network" (claim 10, lines 1-2). Thus, the remote data source 130 in the system taught by Todd et al. most closely corresponds to the management apparatus recited in claim 10 and computer system 110 of Todd et al. most closely corres-

ponds to the user terminal recited in claim 10. As discussed in the Appeal Brief and during prosecution of the application, nowhere in Todd et al. is there any suggestion that "using status information ... is transmitted from the user information general management means to a different vendor other than the software product's vendor" (claim 10, lines 17-19), where, as recited on lines 3-5 of claim 10, the user information general management means is part of the management apparatus that is recited in claim 10.

The only drawing in Todd et al. which shows more than one device connected via a network is Fig. 3. However, according to the description of Fig. 3, "the remote data source (130 of FIG. 1) is a central data source 330" (column 14, lines 41-42), while "remote computer systems 310A, 310B, 310C" (column 14, line 44) are described as supplying "current configuration data" (column 14, line 43) and receiving "software updates" (column 14, line 45) from central data source 330. In other words, remotes 310A-310C are user computers, not vendor computers. No suggestion has been found in Todd et al. of how central data source 330 or remote data source 130 obtain software updates, let alone transmit configuration data to a computer system of **any** vendor. Thus, regardless of whether remote data source 130 or central data source 330 is maintained by a vendor different from a vendor of a software product on computer system 110 or remotes 310A-310C, the limitations recited in claim 10 would not be met, because there is no subsequent transmission from remote data source 130 or central data source 330 to a different vendor as recited on the last four lines of claim 10. Furthermore, Todd et al. contains no suggestion that "inventory information is ... transmitted to ... remote data servers" (Examiner's Answer, page 11, lines 18-19, emphasis added). There is only a single remote data server in each of the embodiments illustrated and described in Todd et al.

Claim 1, using slightly different language than claim 10, recites "[a] computer implemented management system" (claim 1, line 1), including "user information general management means for generally managing user registration information ... transmitted from the user" (claim 1, lines 3-5) that most closely corresponds to the remote data source 130 or central data source 330 taught by Todd et al. Claim 1 also recites that "the user registration information and the using status information ... is transmitted from the user information general management means to the vendor registration/reference means of a vendor of the particular software product and to another vendor" (claim 1, lines 26-29). However, in the system taught by Todd et al., as discussed above with respect to claim 10, there isn't even one, let alone the two vendor systems recited in claim 1, which receive user information from the remote data source 130 or central data source 330. All that is disclosed in Todd et al. is that somehow data sources 130, 330

receive information from a vendor of software, not that data sources 130, 330 supply user information to any vendor. Thus, clearly Todd et al. taken alone does not contain any hint of a system that communicates with both users and vendors in the manner recited in the independent claims.

Fawcett Does Not Suggest Modification of Todd et al.

Item (10)(b) on page 10 of the Examiner's Answer addressed the additional teachings of U.S. Patent No. 5,845,077 to Fawcett. Nothing on page 10 of the Examiner's Answer or in the rejection of the claims set forth on pages 3-7 of the Examiner's Answer contains any indication that Fawcett suggests modification of the system taught by Todd et al. to transmit information from the remote data source 130 or central data source 330 to a single vendor as recited in claim 10, or to at least two vendors as recited in claim 1. Rather, item (10)(b) in the Examiner's Answer asserts that column 7, lines 3-7 of Fawcett discloses "an inventory of all of the computer software on the user's computer" (Examiner's Answer, page 10, lines 11-12, emphasis in original). First, it is noted that once again, the Examiner has cited a portion of one of the references that was not cited prior to the Appeal Brief. Second, this newly cited portion of Fawcett does not add anything of significance to the newly cited portion of Todd et al. The key issue is not whether information about other vendors is obtained from the user's computer, but rather what the system, referred to as an "update service computer" (e.g., column 7, line 2) in Fawcett, does with the information it receives from the user's computer. The claims require that the information is transmitted to at least "a different vendor" than the vendor of the software to which the information relates. The point of the arguments in the Appeal Brief and the responses submitted during prosecution of the application is that Fawcett, like Todd et al., fails to teach an update service computer which receives information about a particular software product from a user computer and then transmits that information to a software vendor that is not the vendor of the particular software product. Thus, adding the teachings of Fawcett to Todd et al. does not result in a system that meets the limitations recited in the independent claims.

Conclusion

For the above reasons and the reasons discussed in the Appeal Brief and the responses filed during prosecution of the application, it is submitted that claims 1-6, 8 and 10-20 patentably distinguish over Todd et al. in view of Fawcett. Thus, it is respectfully submitted that the Examiner's final rejection of the claims is without support and, therefore, erroneous. Accord-

ingly, the Board of Patent Appeals and Interferences is respectfully urged to so find and to reverse the Examiner's final rejection.

Please charge any required fee in support of this Reply Brief to our Deposit Account No. 19-3935.

Respectfully submitted,

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